

REMARKS

The Examiner provides a number of rejections and objections and we list them here in the order in which they are addressed:

- I. Claims 51 - 57 are rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite.
- II. The Specification Is Objected To For Allegedly Containing Active Executable Code
- III. The Claims Are Rejected As Being Obvious
 - A. Claims 37, 39, 40, 42-50 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over United States Patent No. 6,033,861 To Schafer *et al.* or United States Patent No. 6,015,670 To Goodfellow.
 - B. Claims 37, 39, 40 and 42-50 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over United States Patent No. 6,033,861 To Schafer *et al.*, United States Patent No. 6,015,670 To Goodfellow in view of Kohler *et al.* (J Natl Cancer Inst, 85:1513-1519 (1993) or Guay-Woodford *et al.* (Kidney Intl, 50:1158-1165 (1996).

I. Claims 51 - 57 Are Not Indefinite

The Examiner rejects Claims 51 - 57 under 35 USC § 112 ¶ 2 on the basis that "Newly added claim 51 is unclear in the recitation of "[,wherein said treating is under ... stem cells is produced]" in step (c). *Office Action*, pg. 4. The Examiner points to a typographical error occurring in Claim 51 that only appears in the clean set of amended claims, not in Appendix II. This typographical error was inadvertantly retained from a portion of a marked-up version of a presently canceled claim. Claim 51 is now amended to remove the bracketed portion, thereby improving the clarity of Claims 51 - 57. While making this amendment to Claim 51, the Applicants noted an inadvertant duplication of the term "cell", please note that

the second appearance of the term "cell" has been deleted. Also, the term "substantially" has been voluntarily removed from the claims as the Applicants believe the term is unnecessary.

The Examiner is requested to note that this amendment renders the objection to Claim 51 moot. The Applicants, therefore, respectfully request the Examiner remove the 35 USC § 112 ¶ 2 rejection. Moreover, since the Examiner has noted these claims are free of the art, Claims 51 - 57 should be passed to allowance.

III. The Specification Does Not Contain Executable Code

The Examiner asserts that the Applicants' specification contains an embedded hyperlink and/or other form of browser-executable code and states that:

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. *Office Action*, pg. 3.

The Applicants have removed "http://" from two web site addresses appearing as references within the specification. The Applicants now respectfully request the Examiner to withdraw the objection.

III. The Claims Are Not *Prima Facie* Obvious


To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and *MPEP* § 2142; Establishing A *Prima Facie* Case Of Obviousness. The Examiner is reminded that if ONLY ONE of the above requirements is not met, then a *prima facie* case of obviousness does not exist. The Applicants submit that the Examiner's rejection does not meet these criterion. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have canceled Claims 37, 39, 40 and 42-50 (rendering the obviousness rejections moot). These cancellations are made not to acquiesce to the Examiner's argument but only to further the

Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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